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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/311,329	05/11/1999	Mark O Worthington	BURST-3-CIP1	1107
20995	7590	02/07/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			YANG, NELSON C	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			1641	

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/311,329	Applicant(s) WORTHINGTON ET AL.	
	Examiner Nelson Yang	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,9,18,25,28,31,32,35,36,38-48,50-84,87-89 and 92 is/are pending in the application.
- 4a) Of the above claim(s) 35,38-48,50-84 and 92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,9,18,25,28,31,32,35,36,38-48,50-84,87-89 and 92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment of claims 1, 2, 5, 9, 18, 25, 28, 31, 32, 36, 87-89 is acknowledged and has been entered.
2. Applicant's cancellation of claims 3, 4, 6-8, 10-17, 19-24, 26, 27, 29-30, 33-34, 37, 49, 85-86, 90-91 is acknowledged and has been entered.
3. Claims 1-2, 5, 9, 18, 25, 28, 31-32, 35-36, 38-48, 50-84, 87-89 and 92 are pending.
4. Claims 35, 38-48, 50-84, 92 have been withdrawn.

Rejections Withdrawn

5. Applicant's arguments and amendments, see p. 14, filed November 15, 2004, with respect to the rejections of claims 2, 18-31, 33, 46, and 49 under 35 U.S.C. 112, second paragraph, have been fully considered and are persuasive. The rejection of claims 2, 18-31, 33, 46, and 49 under 35 U.S.C. 112, second paragraph, has been withdrawn.
6. Applicant's arguments and amendments, see p. 14, filed November 15, 2004, with respect to the rejections of claims 1-2, 5, 9, 18, 25, 28, 36, and 87-89 under 35 U.S.C. 102 and 35 U.S.C. 103, have been fully considered and are persuasive. The rejection of claims 2, 18-31, 33, 46, and 49 under 35 U.S.C. 112, second paragraph, has been withdrawn.

Claim Objections

7. Claims 5 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

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claim(s) in independent form. The parent claim (claim 1) already recites analyte-specific signal elements disposed confocally with said wobble groove.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-2, 5, 9, 18, 25, 28, 36, and 87-89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, it is unclear how the analyte-specific signal elements would be disposed confocally with the wobble groove such that they would be readable concurrently with said wobble groove, and a definition for this limitation could not be found in the specification. It is not entirely clear if this limitation would indicate that the signal elements would be disposed substantially within the wobble groove, or if they would be outside the wobble groove. In addition, it is unclear what is performing the reading, rendering it unclear which patterns would be readable concurrently with the wobble groove, and which ones would not.

10. The remaining claims are indefinite due to their dependence on an indefinite claim.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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12. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, support for the limitation that the analyte-specific elements are readable concurrently with said wobble groove could not be found in the disclosure. If applicant could point out the location in the disclosure where this limitation could be found, it would be greatly appreciated.

Double Patenting

13. Claims 1-2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22-27 of copending Application No. 09/566,056. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 2, as currently amended, cause the scope of the claims to read upon those of the copending application. In particular, both applications now deal with a trackable optical disc with analyte material or analyte-specific signal elements disposed confocally with a wobble groove such that they are readable concurrently with the wobble groove by a single optical pickup by an optical disc reader.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

14. No claims are allowed.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson Yang whose telephone number is (571) 272-0826. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V Le can be reached on (571)272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nelson Yang
Patent Examiner
Art Unit 1641



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

02/04/05